

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-26 are pending in the present application, with Claims 1-2 amended and Claims 3-26 added by the present amendment.

In the outstanding Office Action, Claims 1 and 2 were rejected under the judicially created doctrine of obviousness-type double patenting in view of Claims 1 and 2 of U.S. Patent 6,701,301 to Ho (hereinafter Ho '301); Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by McCurdy et al. (US20020035697A1, hereinafter McCurdy) and Claim 2 was rejected under 35 U.S.C. § 102(e) as being anticipated by McCurdy or, in the alternative, obvious in view of McCurdy under 35 U.S.C. § 103(a).

The specification is amended to describe features indicated in Figure 3b. No new matter is added.

Claims 1 and 2 are amended to recite a step of displaying a first and second book thickness indicator, each of said first and second book thickness indicator being proportional to a number of pages in a respective discrete content amount. Support for these amendments is found in Applicants' originally filed specification.¹ Support for new Claims 4-10 and 21-26 is also found in Applicants' originally filed specification.² New Claims 11-20 are directed to apparatus and computer program product embodiments of Applicants' claimed invention corresponding to the methods recited in Claims 1 and 3-10. No new matter is added.

Applicants respectfully submit that amended Claims 1-2 distinguish over Ho '301. However, to expedite progress toward allowance, Applicants have also filed a terminal disclaimer herewith relative to Ho '301.

¹ Specification, Figure 1b; also Figures 1-4 of U.S. App. Ser. No. 09/617,043 and Figure 10 of U.S. App. Ser. No. 08/992,793 (now U.S. Patent No. 6,407,757), both of which were identified in the cross-reference section of the present application as having been incorporated by reference.

² Specification, Figures 1-3.

Briefly recapitulating, amended Claim 1 is directed to a method for electronically inserting advertisement into displayed content. The method includes a) organizing sequentially a content into more pages than what are simultaneously viewed on a single display; b) inserting an advertisement at a location within the content, the content now including the advertisement; and c) dividing the content into a plurality of discrete content amounts. The method also includes d) displaying at least two of the discrete content amounts; and e) advancing to a selected discrete content amount other than the at least two discrete content amounts. The displaying step includes displaying two of the discrete content amounts in a book representation. The book representation includes a first and second book thickness indicator. Each of the first and second book thickness indicators is proportional to a number of pages on a respective side of the book representation. The advancing step includes displaying a page flipping to the selected discrete content amount. The claimed invention allows for improved user browsing and marketing efficiency.

McCurdy discloses a system and method for distributing and viewing electronic documents, including the insertion and display of advertisements.³ As acknowledged by the Official Action, McCurdy does not explicitly disclose any thickness indicator, let alone the thickness indicator recited in Applicants' original Claim 2. In fact, McCurdy does not use the term 'thickness' or provide an illustration that corresponds to a displayed thickness. Applicants traverse the finding that Applicants' originally claimed thickness indicator was inherent to the disclosure of McCurdy. Applicant respectfully submits that the assertion of inherency is insufficient to show that McCurdy inherently teaches the claimed thickness indicator because the rejection fails to show "that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art"⁴

³ McCurdy, paragraph [0007], [0008], and [0201].

⁴ See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed.

However, to more clearly describe and distinctly claim Applicants' invention, Claims 1 and 2 are amended to recite a first and second book thickness indicator, where each of the first and second book thickness indicators is proportional to a number of pages on a respective side of the display. Applicants submit that McCurdy does not disclose or suggest a first and second book thickness indicator, where each of the first and second book thickness indicators is proportional to a number of pages on a respective side of the display.

As McCurdy does not disclose or suggest all the elements of independent Claims 1-2, Applicants submit the inventions defined by Claims 1-2, and all claims depending therefrom, are not rendered obvious by the asserted prior art for at least the reasons stated above.⁵ Because of McCurdy's failure to disclose or suggest any thickness, let alone Applicants' claimed book thickness indicator, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that any further rejection of Claims 1-2, and all claims dependent therefrom, in view of McCurdy can be understood.⁶

Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," Id. at 1269 (citation omitted)).

⁵ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

⁶ MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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